PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Francis AMOAH — Group Art Unit: 3739

Application No.: 10/727,618 — Examiner: R. ROLLINS

Filed: December 5, 2003 — Docket No.: 114975

For: ELECTROSURGICAL METHOD AND APPARATUS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

After entry of the Notice of Appeal filed herewith, Applicant respectfully requests review of the Final Rejection mailed February 7, 2006, in the above-identified application. Claims 1, 3, 4, 6, 8-10 and 12 are pending. All are finally rejected. No amendments are being filed with this Request.

Review is requested for the following reasons.

Claims 1, 3, 6, 8-10 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Stern et al., U.S. Patent No. 5,755,715 (Stern).

As stated in MPEP §706.02(j), a *prima facie* case of obviousness for a §103 rejection requires satisfaction of three basic criteria: there must be some suggestion or motivation either in the references or knowledge generally available to modify the references or combined reference teaching, a reasonable expectation of success, and the references must

teach or suggest all of the claim limitations (emphasis added). As discussed below, such a case has not been established.

Applicant has repeatedly pointed out that the Office has attributed to Stern capabilities that are not identified in Stern and are in fact taught away from. The Office has failed to establish a *prima facie* case of obviousness, instead repeatedly taking positions that Applicant has rebutted, the adopted positions based on alluded to capabilities that are not supported by the teaching of Stern or any other art of record.

As an example, in the current Action, in response to arguments, the Action states that differences in temperature do not support the patentability of the subject matter unless there is evidence indicating that such temperature is critical. The Action goes on to say where general conditions of a claim are disclosed in the prior art is not inventive to discover the optimum or workable ranges by routine experimentation. Lastly, the allegation is made that Stern discloses the general conditions of the claim and Applicant has not provided evidence showing that the claim temperature ranges are critical.

Such statements are counter to every response filed by Applicant throughout prosecution. Further, they ignore the teaching of Stern and the requirements for establishing a *prima facie* case of obviousness.

Starting with the Amendment filed November 9, 2004, when responding to a rejection, under 35 U.S.C. §102 over Stern, on page 9, line 9 through page 10, line 19, Applicant pointed out the specific teachings of Stern, how they differed from Applicant's claims and why Stern did not anticipate the invention. This was based upon amendments to claims 1 and 6 to make clear a critical distinction between the two inventions.

When the Office maintained the rejection in a subsequent Final Office Action, Applicant provided a more detailed analysis of the distinctions in a Request for Reconsideration filed on March 24, 2005, in which the principal discussion directed to the

distinctions is found on page 3 through page 5, line 17, which rebut the Office's position concerning equilibration or what action actually takes place in the two different devices. Specifically, in one heating program, the only one with two levels, Stern levels off at a low thermal mapping temperature (col. 9, line 63 - col. 10, line 12) whereas Applicant's far higher temperature is used to equilibrate the probe, i.e., balance the temperature throughout the probe, an action that is nowhere contemplated by Stern and has never been rebutted by any documented record.

When the Office maintained the rejection via an Advisory Action, Applicant further amended the claims to precisely define the two temperatures at which Applicant's invention operates. In an Amendment After Final filed May 6, 2005, from the middle of page 6 through the first paragraph on page 8, Applicant again pointed out that the Office had not shown Stern anticipates the claimed invention. Following another Advisory Action, Applicant filed a Request for Continued Examination leading to entry of the Amendment After Final which subsequently resulted in another rejection. This time the rejection was under 35 U.S.C. §103.

In a Request for Reconsideration filed November 22, 2005, Applicant again addressed the Office's continued "opinions" with respect to teaching and the state of law. Starting in the first complete paragraph on page 2 through the middle of page 3, Applicant responded to the Office's "opinions." From that point on through page 4, the next to last paragraph, Applicant summarized all art cited in the application and pointed out that none taught or suggested what the Office continues to maintain would be obvious to one skilled in the art.

The Office has never provided any teaching that establishes a *prima facie* case of obviousness, let alone one of anticipation. It is respectfully submitted that nowhere in the art of Stern is there any suggestion of the subject matter of claims 1 and 6 as currently presented. Stern does not teach equilibration temperature nor does he teach ablation at the temperatures Applicant claims. At best, Stern teaches a thermal mapping temperature which gives an

indication of how rapidly the probe temperature changes with respect to current, i.e., a first mapping temperature, and then applies sufficient current to reach Stern's taught ablation temperatures, which are, in all cases, in a range between 50 and 90°C and preferably around 70°C (col. 10, lines 9-11). Such an ablation temperature is considerably below Applicant's claimed final temperature of 100-115°C. Further, as noted throughout prosecution, Stern's thermal mapping temperature is somewhere around 45-50°C which is not extremely close to Stern's final ablation temperature and is considerably below Applicant's claimed equilibration temperature of 90-105°C. In fact, Applicant's equilibration temperature is above Stern's preferred ablation temperature.

As the Office has provided no teachings to rebut Applicant's arguments and there is nothing in the record that rebuts Applicant's arguments, it is respectfully submitted that a *prima facie* case of obviousness has never been established, or, if one assumes an initial case was established, it has been rebutted. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Further, in view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Thus, favorable reconsideration and prompt allowance of claims 1, 3, 4, 6, 8-10 and 12 are earnestly solicited.

Should the Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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